

11

cause of action, and venue herein is proper.

2. Defendants have not overcome the statutory presumption of validity of the patent-in-suit.

3. The patent-in-suit and each of the claims thereof are valid.

4. Plaintiff has adequately marked the products sold under its patent-in-suit.

5. The accused structures do not infringe any of the five claims of the patent-in-suit.

6. All affirmative relief asked for by any of the parties should be denied, with the exceptions that the patent-in-suit should be declared valid and the costs should be taxed against the plaintiff.

7. Judgment shall be entered in accordance with these conclusions of law.

50 CCPA

### Court of Customs and Patent Appeals

In re WILKINSON AND BOOTHE

Appl. No. 6723 Decided July 11, 1962

### PATENTS

#### 1. Affidavits—Anticipating references (§ 12.3)

Rule 131 affidavit is not required to show an actual reduction to practice, including a showing of use, to overcome reference publication which discloses claimed compound and its identification but does not allege or disclose a use for compound, it not being alleged that any use is obvious; since applicants show that they did everything done by author of publication prior to publication date, they have overcome publication as a ground of rejection.

#### Particular patents—Nitriles

Wilkinson and Boothe, Nitriles of the Tetracelines, claims of application allowed.

Appeal from Board of Appeals of the Patent Office.

Application for patent of Raymond G. Wilkinson and James H. Boothe, Serial No. 488,122; Patent Office Division 6. From decision rejecting application, applicants appeal. Reversed; Rich and Smith, Judges, concurring with opinions.

NORTON S. JOHNSON (WILLIAM P. SPIELMAN of counsel) both of Stamford, Conn., for appellants.

CLARENCE W. MOORE (JOSEPH SCHIMMEL

of counsel) for Commissioner of Patents.

Before WORLEY, Chief Judge, RICH, MARTIN, and SMITH, Associate Judges, and KIRKPATRICK, Judge.\*

WORLEY, Chief Judge.

Appellants applied for a patent on "Nitriles of the Tetracelines"<sup>1</sup> in February 1955. The examiner rejected the application on the single reference Stephens et al., an article disclosing the preparation and identification of the claimed compound, which was published in a scientific journal in July 1954.

Appellants attempted to overcome the rejection by filing affidavits pursuant to the provisions of Rule 131<sup>2</sup>. In holding those affidavits insufficient to overcome the reference, the examiner stated that they "lacked the *essential element of utility* which is necessary for the reduction of the invention to practice and thus a completion thereof." In affirming, the board said:

We agree with the examiner's position that in order to overcome the reference, it was necessary for the appellants herein to show complete

\* United States Senior Judge for the Eastern District of Pennsylvania, designated to participate in place of Judge O'CONNELL, pursuant to provisions of Section 294(d), Title 28, United States Code.

<sup>1</sup> Since the issue here is one of law, a technical description of the compound is unnecessary.

<sup>2</sup> 131. *Affidavit of prior invention to overcome cited patent or publication.* (a) When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than one year prior to the date on which the application was filed in this country. (b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or their absence satisfactorily explained.

reduction to practice of the invention and particularly to show the utilization of the compound. \* \* \*

Summarizing the facts of record as we understand them, we have the following situation:

1. The Stephens publication discloses the claimed compound and its identification. It does not allege a use for the compound, it does not show a use, nor is any use alleged to be obvious.

2. Appellants' affidavits prove that appellants had made and identified the claimed compound prior to the publication date of the Stephens reference. The affidavits do not allege a use for the compound, they do not show a use, nor is any use alleged to be obvious.

3. The legal adequacy of the present application for a patent on the compound is not questioned.

[1] Since the Stephens reference does not allege or disclose a use, nor is a use alleged to be obvious, the issue is whether, under such circumstances, appellant can properly be required to show an actual reduction to practice, including a showing of use, to overcome the reference. In other words, if Stephens shows A, can appellant be compelled to show A *plus* B before he can overcome Stephens? We do not think so, nor do we find any authority for such a requirement in the cases relied on below.<sup>3</sup>

We acknowledge the varying degrees of relevance of the cases cited below, as well as by opposing counsel here, but find none, including *In re Guido H. Stemple, Jr.*, 44 CCPA 820, 241 F.2d 755, 113 USPQ 77, sufficiently in point with the precise fact situation at bar to be controlling.

Since appellants have satisfactorily shown they did everything done by Stephens *prior* to the latter's publication date, they have overcome Stephens as a valid ground of rejection. Thus, we are obliged to *reverse* the decision appealed from.

MARTIN, Judge, concurs in result only.

RICH, Judge, concurring.

<sup>3</sup> During the proceedings below the examiner and board cited the following: *Conner v. Joris*, 44 CCPA 772, 241 F.2d 944, 113 USPQ 56; *Smith v. Bousquet*, 27 CCPA 1136, 111 F.2d 157, 45 USPQ 347; *Harry P. Townsend v. Henry L. Smith*, 17 CCPA 647, 36 F.2d 292, 4 USPQ 269; *Larsen v. Marzall*, 90 U.S. App. D.C. 260, 195 F.2d 200, 92 USPQ 306; *Knutson et al. v. Gallsworthy et al.*, 82 U.S. App. D.C. 304, 164 F.2d 497, 74 USPQ 324; *Ex parte Buc et al.*, 114 USPQ 552 (Bd. App. 1957); *Collins v. Trumpler*, 105 USPQ 341 (Bd. Pat. Inter. 1954); *Ex parte Fryling et al.*, 1957 C.D. 43, 115 USPQ 99 (Bd. App. 1954); *Ex parte Grosselin*, 1901 C.D. 248.

I concur in the result. The principles I believe to be applicable here are stated in *In re Guido H. Stempel, Jr.*, 44 CCPA 820, 241 F.2d 755, 113 USPQ 77. The principles to which I refer are set forth, point by point, in the last six paragraphs of the opinion.

I also wish to express full agreement with Judge Smith's concurring opinion.

SMITH, Judge, concurring.

While I am in full agreement with the result reached by the majority, its opinion does not set forth certain fundamental considerations which have influenced my views.

The facts of the present case lead me to the same conclusion as that reached by the majority, i.e., since the Stephens et al. reference discloses the claimed compound and its identification but does not allege nor show a use, then all appellants need to show in their affidavit under Rule 131 to overcome the effect of the Stephens et al. publication is that they made and identified the claimed compound before the effective date of the publication.

As summarized in the solicitor's brief:

\* \* \* [Although] the statutes nowhere expressly provide that the bar of a novelty negating reference may be overcome or removed, Rule 131, like its predecessor Rule 75, provides the means and manner in which an applicant may overcome the *apparent* lack of novelty because of an earlier publication, and, therefore, an *apparent* bar, under 35 U.S.C. 102(a). \* \* \* [Emphasis added.]

No doubt the solicitor meant that the statutes provide no *procedure* for overcoming a reference which only *prima facie* negatives novelty. This is not unusual. But the statutes do give a right for which some procedural remedy is necessary.

The solicitor's brief summarizes what has been said in many of the decisions in which former Rule 75 and present Rule 131 have been considered as follows:

\* \* \* The language of the rule and its interpretation through almost a century all combine to show that, while paragraph (b) of present Rule 131 is new, it merely incorporates the practice and construction which was considered implicit in the old rule. Hence, to apply correctly and properly the requirements of the rule it is essential to know what the terms "completion of the invention", and "reduction to practice" mean in interference law and practice.

The solicitor then argues that the present issue should be determined by

analogy to an interference proceeding. While there is no issue here of priority between rival inventors in the sense of an interference proceeding arising under 35 U.S.C. 102(g), it seems to me that if the solicitor's argument is to be pursued, it is necessary to first assume that the reference publication stands in the position of a prior filed application.<sup>1</sup> In this situation Rule 202 presumably would be addressed to appellants who, in this analogy, stand in the junior party position. The statement showing prior conception of the invention contained in appellants' affidavit under Rule 131 would in my opinion be sufficient under Rule 202 "to establish *conception* of the invention under consideration for the purpose of establishing priority of invention". [Emphasis added.]

If we are to pursue the interference analogy suggested by the solicitor to this point, it then seems to me the analogy should be pursued to its logical end. On this basis, the reference publication, when viewed in the light of an inter partes interference proceeding, would not constitute a constructive reduction to practice of the invention. It would have no "effective date" as a reduction to practice under the applicable principles of patent interference law. On this basis, therefore, appellants should prevail on their application since they are entitled to its filing date as a constructive reduction to practice, which on the present record is the earliest date established for any reduction to practice.

Thus, I would agree with the position taken in appellants' brief that:

If this were an interference, appellants would only have to show that they were first to conceive the compound of Claim 15. This would entitle them to priority because:

(a) The Stephens et al. publication is evidence of conception only; not of reduction to practice. In re Schlittler et al., 43 CCPA 986, 110 USPQ 304.

(b) Appellants are the first to reduce their claimed invention to practice. They did this on February 14, 1955 (R1) by filing the application on appeal. Rivise and Caesar, "Interference Law and Practice", Vol. 1, § 154, pages 493-4.

(c) Priority of invention belongs to the party who was the first to

reduce to practice when he was also the first to conceive; no showing of diligence is necessary. Ibid. § 173, page 538.

To avoid this resolution of the issue, the solicitor and the board have relied upon statements found in ex parte cases which deal with the effect of disclosures in a reference which is a statutory bar under 35 U.S.C. 102(b). It seems to me that these cases only confuse the issue here. I am unwilling to extrapolate a rule of construction from such ex parte cases where the issue under 35 U.S.C. 102(b) relates to the extent of the *statutory bar* created by prior publication and to apply this rule of construction to a proceeding such as the present in which a Rule 131 affidavit is relied upon to establish *novelty* over a reference publication. As I see it, there are entirely different public policy considerations which are involved in these two situations.

The extent to which a publication is effective as a statutory bar under 35 U.S.C. 102(b) must be determined on the basis of the public policy consideration which does not permit the patenting of an invention which the publication has disclosed to the public more than one year before applicant's filing date. In this instance, the legitimate inquiry is, what did the publication donate or abandon to the public? Cf. In re Shackell, 39 CCPA 847, 194 F.2d 720, 93 USPQ 34.

Congress has seen fit to provide that an invention disclosed in a publication is not donated or abandoned to the public until one year after the date of publication. Thus, the grant of a patent on an application filed, as here, less than one year from the date of publication, is not barred by the statute. The applicant who thus files his application is entitled under 35 U.S.C. 102(a) to establish dates which permit a determination of the question of novelty of his invention over the publication.

It is for these reasons I agree the board decision should be reversed. On this record, appellants have established by their affidavit that they conceived the invention prior to the date of the reference publication and the reference fails to establish any reduction to practice. Under these circumstances, it seems to me, this showing should constitute an adequate compliance with Rule 131, even if one accepts the solicitor's theory that interference case law should apply.

Since the question is not "priority" in the interference sense, however, but only novelty under section 102(a), there is no question but that the novelty-negating effect of the reference has been completely overcome.

<sup>1</sup> This assumption is not valid on its face since the publication here does not comply with 35 U.S.C. 112 and it would not be assigned a filing date. However, for purposes of pursuing the solicitor's analogy, it is necessary to make this assumption.